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Serial No. 10/815,004

REMARKS

Claims 1-6, 8, 9 and 11-24 were finally rejected in the last Office Communication.

In this response, Claims 1, 4, 5, 8, 9, 12, 13, 15, 18, 19, and 20 are amended. Claims 3 and 6 are cancelled. Claims 1-5, 8, 9, and 11-24 remain pending.

The claims are amended based on the status of the claim amendments made after receipt of the final rejection and prior to receipt of the Advisory Action.

Support for the amendments is found in the specification and drawings as originally filed, including the disclosure of the marker deployment rod and cutter seat having a diameter greater than the diameter of the cutter, such as is disclosed at paragraphs 29-30. No new matter is added.

It is respectfully urged that the amendments address the Examiner's concerns set forth in the advisory action and that the claims, as amended, distinguish over the art cited by the Examiner in making the final rejections.

102 Rejection:

The Examiner rejected Claims 1, 3, 8, 9, and 11 as anticipated by Barsch, US 6,234,177. It is respectfully urged that a claim is anticipated only if each and every element of the claim is found in a single prior art reference. It is respectfully urged that Barsch '177 does not teach, or even suggest, all the elements of the rejected claims.

For instance, Barsch '177 does not appear to disclose or suggest advancing a cutter to drive a marker deployment rod to deploy a marker; a marker deployment rod or pusher element having a cutter seat; and/or a cutter seat having a diameter greater than the diameter of a cutter.

Accordingly, Barsch ('177) does not anticipate amended claims 1, 3, 8, and 9, or Claim 11 which depends from Claim 1.

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Obviousness Rejections:

The Examiner also Claims 2 under 35 U.S.C. 103(a) as being unpatentable over Barsch ('177) in view Burbank et al. (U.S. Patent No. 6,161,034). This rejection is improper for the reasons set forth above, and also because the Examiner has not made out a *prima facie* case of obviousness.

In order for a *prima facie* case of obviousness of a claim to exist, the prior art reference or combination of references must teach or suggest all of the limitations of the claim. MPEP § 2143.03. It is respectfully urged that even if one combined the references as suggested by the Examiner, the resulting combination would not provide all the limitations of the amended claims.

Additionally, there must be some teaching, suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art, in order for a *prima facie* case of obviousness to exist. MPEP § 2143.01. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Actual evidence of a suggestion, teaching or motivation to combine prior art references must be shown. *In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999). Broad conclusory statements, standing alone, simply are not evidence. *Id.* Motivation to combine or modify will be lacking if the art teaches away from a claimed combination. MPEP § 2145.

It is respectfully urged that, with respect to all the obviousness rejections, the Examiner has not identified evidence of a suggestion or motivation to modify or combine the teachings of the references as required by MPEP § 2143, but instead has merely reconstructed the claimed invention based on improper hindsight reliance on the Applicant's disclosure.

MPEP § 2143.01 admonishes that "[t]he mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (Emphasis in original.) Actual evidence of a suggestion,

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teaching or motivation to combine prior art references must be shown. *In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999). Conclusory statements regarding the teaching of references, standing alone, simply are not evidence. *Id.* Thus, the requirements of MPEP § 2143.01 for a *prima facie* case of obviousness are not met. *See In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999). The Examiner has not provided the requisite evidence in the prior art suggesting the desirability of the combinations claimed herein. Because evidence of a motivation to combine references required by MPEP § 2143.01 is lacking, Applicant respectfully requests that the rejections be withdrawn.

Claims 4 and 5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Barsch ('177) in view Zarins et al. (U.S. Patent No. 6,605,047).

It is respectfully urged that even if one combined the references, the combination would not teach all the element of the claims, as amended, for at least the reasons set forth above with respect to amended Claim 1.

The Examiner has rejected Claims 12-15 and 17-19 under 35 U.S.C. 103(a) as being unpatentable over Barsch ('177) in view Burbank et al. (U.S. Patent No. 6,662,041).

It is respectfully urged that even in one combined the references as suggested by the Examiner, the resulting combination would not teach all the elements of the amended claims.

Regarding Claim 12, as amended, it is respectfully urged that the references, even if combined, do not teach a biopsy marker introduction device having an introducer tube configured to be received with a cutter lumen; a marker, and a marker deployment rod disposed in the introducer tube and having a cutter seat; nor a marker deployment rod having a length adapted for cooperation with a cutter such that when the marker deployment rod is inserted into the cutter lumen, distal advancement of the cutter drives the marker deployment rod.

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Regarding the rejection of Claim 20, it is respectfully urged that the prior art cited by the Examiner does not teach or suggest a biopsy system which includes, among other things, a marker introduction device comprising an introducer tube configured to be received in a cutter lumen of a biopsy probe; a marker slidably disposed in the introducer tube; and a pusher proximal of the marker and having a proximal cutter seat having a diameter greater than that of the cutter.

Conclusion

In light of the amendments and remarks made herein, it is respectfully submitted that the claims currently pending in the present application are in form for allowance. Accordingly, reconsideration of those claims, as amended herein, is earnestly solicited.

Respectfully submitted,

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